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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,912	10/15/2003	William Fiehler	47563.0011	6302
57600	7590	01/10/2008		
HOLLAND & HART LLP P.O. Box 11583 60 E. South Temple, Suite 2000 Salt Lake City, UT 84110			EXAMINER RYCKMAN, MELISSA K	
			ART UNIT 3773	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/685,912

Applicant(s)

FIEHLER ET AL.

Examiner

Melissa Ryckman

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/07 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 14 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Nash et al. (US 5662681).

Regarding Claim 1, Nash teaches a tissue puncture closure device for partial insertion into and sealing of an internal tissue wall puncture comprising: a filament (34) extending from a first end of the closure device to a second end of the closure device; an anchor (32) for insertion through the tissue wall puncture, the anchor being attached to the filament at the second end of the closure device (Fig. 2); a sealing plug (30) slidably attached to the filament and positioned adjacent to the anchor (fig. 2); a tamping tube (20) disposed adjacent (the examiner gives the broadest interpretation to

the word adjacent and interprets adjacent as being near) to the sealing plug and an automatic driving mechanism (36) that tamps the sealing plug utilizing force generating by withdrawal of the closure device from the internal tissue wall puncture (fig. 3) to move the tamping tube toward the sealing plug (30).

Regarding Claim 14, Nash teaches the device of claim 1, wherein the filament extends at least partially back from the anchor toward the proximal end and re-engages the sealing plug (fig. 2).

Regarding Claim 39, Nash teaches a method of sealing a tissue puncture in an internal tissue wall accessible through a percutaneous incision comprising: providing a tissue puncture closure device comprising a tamping member (20) and a filament (34) coupled (via 34 the tamping and anchor are connected) to an anchor (32) and to a sealing plug located proximal of the anchor for disposition and anchoring about the tissue puncture; inserting the tissue puncture closure device into the percutaneous incision; deploying the anchor; withdrawing the closure device from the percutaneous; automatically tamping the sealing plug toward the anchor end upon withdrawal of the closure device from the internal tissue wall puncture (Columns 5-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nash et al. (US 5662681).

Regarding Claim 31, Nash teaches a method of sealing a puncture in an internal tissue wall accessible through a percutaneous incision, comprising; withdrawing a closure device from the percutaneous incision; automatically transducing a motive force generated by withdrawal of the closure device in a first direction to move a tamping member (20) to provide a tamping force in a second direction (Column 7, proximate lines 28-36). Nash does not specify removing the tamping member from the percutaneous incision, however it would have been obvious to one of ordinary skill in the art to move the tamping member as this leaves the anchor in place.

Regarding Claim 32, Nash teaches the method of claim 31, further comprising applying the tamping force in the second direction to a sealing plug (30).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application Nos. 11/130895, 11/130688, 11/103730 and 11/103257. Although the conflicting claims are not identical, they are not patentably distinct from each other because they relate to the same inventive concept, that being a tissue puncture closure device comprising a filament, an anchor, a sealing plug and an automatic driving mechanism for automatic tamping, including a transducer, a spool, a gear, a torque limiting clutch etc.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 10/12/07 have been fully considered but they are not persuasive. The applicant generally argues the following:

- Nash does not have a tamping member

The examiner respectfully disagrees with the applicant, Nash teaches a tamping member as Nash has the structural limitations as set forth in the claims and provides the same functionality as described in the claims.

Regarding the provisional double patenting rejections

The previous provisional patenting rejection with respect to applications 11/130895, 11/130688, 11/103730, 11/103257 are still outstanding. Examiner acknowledges applicants remarks with respect to these applications, however examiner points out that this is a provisional obvious-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Ryckman whose telephone number is (571)-272-9969. The examiner can normally be reached on Monday thru Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number:
10/685,912
Art Unit: 3773

Page 7

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR



(JACKIE) TAN-UYEN HO
SUPERVISORY PATENT EXAMINER